

24. (new). The portable camera of claim 20, wherein the terminal receives image data from one of an external computer, a portable information device, and a public telephone.

25. (new). The portable camera of claim 20, wherein the terminal comprises an infrared unit.

26. (new) The portable camera of claim 20, wherein the terminal comprises a serial driver to conduct a serial data transmission.--

### REMARKS

In the last Office Action, the Examiner rejected claims 1–15 under 35 U.S.C. § 103(a); rejected claims 1, 2, 5–8, and 11 as unpatentable over U.S. Patent 5,325,131 ("*Penney*"); rejected claims 3–4 and 9–10 as unpatentable over *Penney* in view of U.S. Patent 5,361,099 ("*Kim*") under § 103(a); and rejected claims 12–15 as unpatentable over U.S. Patent 5,473,381 ("*Lee*") under § 103(a).

Applicant has canceled claims 1–15 without prejudice or disclaimer of the subject matter contained therein. Applicant has added new claims 20–26, to more appropriately claim the invention. No new matter has been added.

These rejections are respectfully traversed, since a *prima facie* case of obviousness has not been made by the Examiner.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001).) Second, there must be some suggestion or

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motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference sin a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).)

The Examiner correctly acknowledges that "Applicant's invention is not the same as the prior art invention," but goes on to state, "Applicant's claims are written broadly enough where the prior art can be read on it." (Paper No. 6, at 3, 4, and 6.) Because the Examiner has failed to cite references that disclose or suggest each claim element, as set forth below, Applicant disagrees.

Claim 20 recites, *inter alia*:

A portable camera being carried by an operator, comprising: a photographing element for converting photoelectrically an image of an object into electrical image signals; . . . [and] a memory section to accommodate a removable memory unit in which the processing section stores the first image data . . . .

*Penney* discloses a multiformat television switcher. The multiformat television switcher includes a master control switcher 10 that receives an input of video signals and outputs a selected video signal and a control signal. (*Penney*, col. 2, lines 19–24.) The selected video signal is input to a video-format up converter 12, which is then converted into an HDTV video signal. (*Penney*, col. 2, lines 25–27.) The converted HDTV video signal, the selected video signal, the control signal, and HDTV sources are input to an auxiliary selector 14. (*Penney*, col. 2, lines 35–52 and 60–61.) The control signal determines which input video signal is provided to the appropriate output of the auxiliary selector 14. (*Penney*, col. 2, lines 56–60.) Therefore, the multiformat

television switcher selects input signals that may displayed on a standard format video monitor and a HDTV format video monitor.

In contrast, independent claim 20 recites in part, "a memory section to accommodate a removable memory unit in which the processing section stores the first image data," which is plainly lacking in *Penney*. *Penney* neither discloses nor suggests a combination including a memory section, and therefore lacks at least this claim element. Further, this deficiency is not cured by any of the other cited references.

*Kim* discloses a comb filter. The comb filter 80 includes first and second frame memories 80a and 80b for delaying NTSC signals from A/D converter 50 applied through a second switch SW2 one frame at a time. (*Kim*, col. 5, lines 25–33.) The outputs of first and second frame memories 80a and 80b pass to subtractors 80c and 80d, respectively, which subtract an output signal of frame memories 80a and 80b. (*Kim*, col. 5, lines 33–38.) The comb filter 80 further includes a motion detector 80e, which generates motion coefficient K and the value 1–K in response to the output of subtractor 80d. (*Kim*, col. 5, lines 38–42.) Eventually outputs a signal as an NTSC frame color signal and another signals as the NTSC frame luminance signal. (*Kim*, col. 5, lines 43–57.) The comb filter alternatively allows the frame memories 80a and 80b to be used in a decoder 100 to store HDTV signals temporarily when the HDTV signal is received under selection of the user. (*Kim*, col. 5, lines 58–61.) That is, the comb filter discloses using frame memories to delay NTSC signals one frame at a time for processing or, alternatively, in a decoder to temporarily store HDTV signals when an HDTV signal is received.

A comb filter using frame memories to delay NTSC signals one frame at a time for processing or, alternatively, to temporarily store HDTV signals in a decoder when an HDTV signal is received is not the same as a combination including, "a memory section to accommodate a removable memory unit in which the processing section stores the first image data," as recited in independent claim 20. Accordingly, *Kim* fails to compensate for the deficiencies of *Penney*.

*Lee* discloses an apparatus that converts a frame format of a television signal into a display format for a HDTV receiver. The converter includes a scanning format conversion circuit 100, which converts a scanning format of an input video signal to a progressive scanning type signal. (*Lee*, col. 3, lines 52–65.) The scanning format conversion circuit 100 has a line average calculation circuit including a line memory 105 for storing and delaying the input video signal *V<sub>i</sub>* in the line units and outputting the delayed video signal to FIFO memory 102. (*Lee*, col. 6, lines 23–26.) The circuit 100 also has a frame average calculation circuit 120 including field memory 121 for storing the input video signal *V<sub>i</sub>* and a field memory 122 for storing an output signal from field memory 121 in field units. (*Lee*, col. 7, lines 5–14.) That is, the apparatus discloses using a line memory or a field memory to store and possibly delay an input signal.

An apparatus using a line memory or a field memory to store and possibly delay an input signal is not the same as the combination including, "a memory section to accommodate a removable memory unit in which the processing section stores the first image data," as recited in independent claim 20. Accordingly, *Lee* likewise fails to compensate for the deficiencies of *Penney*.

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As pointed out above, to establish a *prima facie* case of obviousness, the cited references in combination must teach or suggest all the claim elements. Because none of the references individually or in combination teach or suggest each claim element, independent claim 20 is patentable over *Penney, Kim, and Lee*.

Further, the Examiner has cited no reference that discloses or suggests at least, "a photographing element for converting photoelectrically an image of an object into electrical image signals" as recited in independent claim 20. The Examiner admits that *Penney and Kim* do "not expressly disclose the use of a camera. However, the Examiner alleges, since [*Penney and Kim*] convert[] image signals, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a camera, comprising a photographing element, be utilized to produce image signals." (Paper No. 6, at 3 and 6.) Applicants disagree and note a bare conclusion of obviousness does not constitute a *prima facie* case for obviousness. The Examiner has identified no reference that discloses or suggests at least "a photographing element for converting photoelectrically an image of an object into electrical image signals" nor any motivation to combine references that include such an element. Moreover, at least because such a combination would not result in the claimed invention, there can be no reasonable expectation of success.

It further appears that the Examiner has relied on Official Notice in alleging that it would have been obvious to use a camera comprising a photographic element to produce image signals. The Examiner is respectfully reminded of the provisions of M.P.E.P. § 2144.03. Further, an Official Notice rejection is proper only in an instance where the facts asserted are well-known, or common knowledge in the art, and capable

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of instant and unquestionable demonstration as being well-known and that it is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based. Accordingly, Applicant requests that the Examiner cite a competent prior art reference in substantiation of these conclusions, provide a personal affidavit, or withdraw the rejection.


In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration, reexamination, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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